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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,338	06/26/2000	Han-Cheng Zhang	ORT-1238	2229

7590

10/06/2004

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EXAMINER

MOHAMED, ABDEL A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/603,338	<b>Applicant(s)</b> ZHANG ET AL.	
	<b>Examiner</b> Abdel A. Mohamed	<b>Art Unit</b> 1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

#### **ACKNOWLEDGMENT OF AMENDMENT, REMARKS, IDS AND STATUS OF THE CLAIMS**

1. The amendment, remarks and information disclosure statement (IDS) and Form PTO-1449 filed 7/12/04 are acknowledged, entered and considered. In view of Applicant's request claims 1-4, 6, 7 and 23 have been amended and claims 11-18 are withdrawn as nonelected invention. Claims 1-23 are now pending in the application. The objection to the trademarks and the rejections under 35 U.S.C. 112, second paragraph, 35 U.S.C. 101 for same invention double patenting and the provisional rejection under the judicially created doctrine of obviousness-type of double patenting are withdrawn in view of Applicant's amendment and remarks filed 7/12/04. However, the rejection under judicially created doctrine of obviousness-type double patenting is maintained for the same reasons discussed on the previous Office action.

#### **ARGUMENTS ARE NOT PERSUASIVE**

##### **HEADINGS FOR NONSTATUTORY DOUBLE PATENTING**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **OBVIOUSNESS-TYPE DOUBLE PATENTING**

3. Claim 1-10 and 19-23 remain rejected under the under the judicially created doctrine of obviousness-type as being unpatentable over claims 1-7 and 16-19 of U.S. Patent No. 6,365,617 in view of Hoekstra et al. (U.S. Patent No. 6,017,890).

Applicant's arguments filed 7/12/04 have been fully considered but they are not persuasive. Applicant has argued that the A1 is on the opposite side of the molecule from A2 in Hoekstra patent and it is not clear how the placement of A1 and A2 in Hoekstra would suggest moving both substituents to the same side of the molecule and substituting A1 and A2 into the formula I of the 617, to replace the left hand side of the '617 patent formula is noted. However, the '617 patent by itself is sufficient for this rejection because R<sub>5</sub> is A1 and R<sub>7</sub> is A2 (See e.g., formula I in claim 1) and as such differs in scope with the instant application. Further, the Hoekstra patent was applied as

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further support to show a compound with A1 and A2, which are D- or L- amino acids selected from the group consisting of alanine, cysteine, serine, leucine, phenylalanine, etc. (See e.g., col. 1, lines 8-35 and claim 1). Thus, since both inventions claim pharmaceutical formulation comprising substantially the same compounds thereof for the same purposes; it is an obvious variation to use or adapt the broader scope or the specific because both pharmaceutical formulations are intended for treatment of thrombin receptor antagonists as discussed in their abstracts and summary of the invention, respectively. Therefore, both inventions are an obvious variation of the other since the same compounds are used for the same purposes, and as such, one of ordinary skill in the art would envision both sets of claims as one invention and obvious variation of each other.

#### **ACTION IS FINAL**

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


### CONCLUSION AND FUTURE CORRESPONDANCE

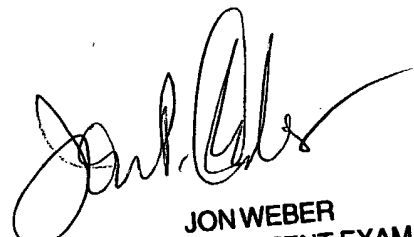
5. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdel A. Mohamed whose telephone number is (571) 272 0955. The examiner can normally be reached on First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (571) 272 0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Mohamed/AAM  
October 4, 2004

  
JON WEBER  
SUPERVISORY PATENT EXAMINER